



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,787	08/28/2001	Daniel M. Marks	110293.123US1	2851

24395 7590 09/24/2003  
HALE & DÖRR LLP  
THE WILLARD OFFICE BUILDING  
1455 PENNSYLVANIA AVE, NW  
WASHINGTON, DC 20004

EXAMINER

MARKS, CHRISTINA M

ART UNIT	PAPER NUMBER
----------	--------------

3713

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/939,787

Applicant(s)

MARKS ET AL.

Examiner

C. Marks

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because the length of the abstract exceeds 150 words and the language used in the abstract does not clearly and concisely define the invention and with the number of symbols that are listed without the proper space to definitely define them, the abstract does not give a clear and concise statement as to what the invention is. Correction is required. See MPEP § 608.01(b).

### ***Claim Objection***

Claim 7 is objected to because of the usage of the squares in the claim. The claim does not follow proper format for presenting a claim and the squares need to be removed.

Claim 13 is objected to because of the usage of the squares in the claim. The claim does not follow proper format for presenting a claim and the squares need to be removed.

Claim 14 is objected to because of the usage of the squares in the claim. The claim does not follow proper format for presenting a claim and the squares need to be removed.

Claim 15 is objected to because of the usage of the stars in the claim. The claim does not follow proper format for presenting a claim and the squares need to be removed.

Claim 19 is objected to because of the usage of a square in the claim. The claim does not follow proper format for presenting a claim and the squares need to be removed.

Claim 23 is objected to because of the usage of the squares in the claim. The claim does not follow proper format for presenting a claim and the squares need to be removed.

Claim 24 is objected to because of the usage of the squares in the claim. The claim does not follow proper format for presenting a claim and the squares need to be removed.

Claim 25 is objected to because of the usage of the stars in the claim. The claim does not follow proper format for presenting a claim and the squares need to be removed.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1- 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 18, 16, and those dependent therefrom are indefinite in that one of ordinary skill in the art would not understand the language of the limitation as to how the player is awarded. The language is not clear and concise in the manner that one of ordinary skill in the art

Art Unit: 3713

would be able to easily ascertain the conditions that are required in order for the player to receive the award. It is not clear which conditions are affected by the at least in lines 11 and 14 and what combinations and elections are actually required to achieve the win.

Claims 9, 13, 19, 23, 24, and those dependent therefrom are indefinite in that one of ordinary skill in the art would not be able to ascertain if the phrase ("Most Valuable Placing": Claim 9 and 19) or ("MVP": claim 13, 23, and 24) is part of the claim language. By the usage of the parenthesis, it is not definite to one of ordinary skill in the art what effect the language enclosed within the parenthesis has on the claim, or if it is part of the limitation.

Claims 9, 14, 19, and those dependent therefrom are indefinite in that one of ordinary skill in the art would not understand what is meant by most valuable winning combination. There is no support in the claim limitation to allow one of ordinary skill in the art to understand what is meant by such a phrase or how the most valuable winning combination is determined.

Claims 17 and 25 are indefinite in that one of ordinary skill in the art would not understand how the symbols can be the same and different at the same time. The language of the limitation is indefinite in that it does not properly convey the relationship of the symbols.

Claim 26 recites the limitation "the predetermined contiguous lines" in lines 12-13. There is insufficient antecedent basis for this limitation in the claim.

Therefore, for examination purposes, the claims will be evaluated as best understood by one of ordinary skill in the art.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3713

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-25, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (US Patent No. 6,093,102) in view of Seelig (US Patent No. 6,533,660).

Bennett discloses a method of playing a game having a display area comprising a plurality of rows intersecting or meeting with a plurality of columns including a plurality of symbols (FIG 5). Bennett allows the player to select at least one symbol location from the plurality of symbol locations (Column 3, lines 54-57). This allows the player to essentially create their own lines of pay in any manner they desire. The system then plays the game as is known in the art by randomly rearranging the plurality of symbols and then displaying them. The player is then awarded when a combination of predetermined symbols appears within the display area in the locations that were selected by the player (Column 2, lines 13-16).

Bennett discloses allowing the player to select the symbol location from a plurality of symbol locations in order to construct paylines. Bennett does not disclose allowing the player to select, in itself, a symbol in order to construct paylines.

Art Unit: 3713

Seelig discloses a game wherein the player is presented with a display area comprising rows and columns wherein the player can select a symbol from a list of symbols that the player may receive (Column 10, lines 42-44). Seelig discloses that by allowing the player to choose their own symbols, the excitement is increased as well as enjoyment (Column 10, lines 65-66). It is also known in the art that by allowing the player to choose their own symbols or indicia, a feeling of greater anticipation is created as the player feels that they are able to incorporate their "lucky" symbols into the game as well as have a control over the outcome, both of which are known in the art to increase the satisfaction and enjoyment of the game to the player.

Bennett allows players to construct their own paylines by choosing symbol locations. Bennett states also that numerous variations to the method can occur without departing from the scope of the invention (Column 5, lines 56-60). One of ordinary skill in the art would recognize the spirit and scope of the Bennett invention is allowing the player to define their own paylines in order to feel a greater control over the payout of the game. One of ordinary skill in the art would recognize another way to allow a player to define their own paylines would be to allow them to choose their own symbols or indicia for use in play as disclosed by Seelig. One of ordinary skill in the art would thus find it obvious to incorporate the teachings of Seelig into the system of Bennett. One of ordinary skill in the art would be motivated to make this incorporation in order to allow the player an even greater level of freedom in constructing the paylines. By allowing the player to choose symbols as disclosed by Seelig, the player can incorporate their own feelings of symbols they perceive as "lucky" or favored in order to construct the paylines. It would thus be obvious to the system of Bennett, which grants the player the freedom to construct paylines, that by incorporating the teachings of Seelig, a player could choose symbols in order to

Art Unit: 3713

construct the paylines. Thus the player would have a greater amount of freedom for incorporating their own control into the game. By allowing the player to construct paylines with symbols instead of just locations they want to use in the game as disclosed by Seelig, the system of Bennett would still allow the player to define their own paylines. However, by allowing the player to define the payline line with the choice of symbols, instead of just a pattern, the system of Bennett would greater accommodate a player's needs by increasing anticipation and excitement as disclosed by Seelig in association with allowing the player to choose their own symbols for use in a game. Thus, overall satisfaction and freedom would be added to the system of Bennett by allowing the player to choose the symbols they want to win on, instead of just the location.

Regarding claims 2, 3, 7 and 16-17, Bennett includes allowing the player to define a payline in any manner they desire. Thus, it would be obvious to one of ordinary skill in the art that when incorporating the teachings of Seelig wherein the paylines would be defined based on a symbol chosen by the player not the locations chosen. One of ordinary skill in the art would understand that standard paylines would be used to ascertain winning combinations. It is disclosed in the prior art of record (Applicant's FIG 2; Bennett: FIG 1) that claimed paylines and paytables are known in the art and that paylines can include symbols that are both the same and different to result in a win and the contents of the payable are design choices obvious to one of ordinary skill in the art.

Regarding claims 4-6, Bennett discloses that when a symbol location is selected it is wagered upon (Column 3, lines 26-29). Bennett also discloses that a number of symbol locations can be chosen (FIG 1). In application of Seelig, one of ordinary skill in the art would understand



Art Unit: 3713

that the symbols were being wagered on and a number of symbols could thus be chosen. It is known in the art that a wager is placed for each part of a payline selected, thus the symbols would have a wager associated with them and it is also known in the art that the wagers can be the same or different for each "payline" depending on the wishes of the player. Thus, in the system of Bennett in view of Seelig, the combination would yield a game wherein the symbols are chosen by the player in order to construct a payline and when a symbol is chosen, it is wagered upon and as is known in the art, any amount of wager can be associated with the location as per the preference of the player.

Regarding claim 8, it is notoriously well known in the art to use a wild symbol as one of the plurality of available symbols in a slot machine matrix, and the usage of such would be obvious to a skilled artisan as a means to supplement a payline. The usage of such wild symbols would be obvious to the system of Bennett in view of Seelig as a means to further attract players as the player would feel that the wild symbol allows them even more opportunity to gain wins.

Regarding claims 9-12, 15, 19-22, and 25, the usage of certain symbols and combinations of symbols are known in the art as a means to enter a bonus round or supplement awards. Bonus rounds themselves are notoriously well known in the art as a way to further attract the player to the gaming machine as well as keeping the player at the machine. Bonus games including repositioning, moving a character, or choosing hidden items are known in the art. The actual graphic nature and style of the bonus game is a design choice and it is thus obvious to change and adapt. Such attractions would be obvious to the system of Bennett in view of Seelig to further attract players and keep them at the machines. The actual symbols and combinations used, as well as the format of the bonus round itself, are well within the capability of the game

Art Unit: 3713

designer to be adapted to the needs and theme of the certain game and thus the usage of such would be obvious to one of ordinary skill in the art as that of the design choice of the game programmer.

Regarding claims 13-14 and 23-24, scatter pays and moving symbols are also known in the art and thus would be obvious to a skilled artisan. Likewise, it would be obvious to incorporate this feature into the system of Bennett in view of Seelig to provide further means to attract and keep the player, as their sense of achieving a greater winning would be increased.

Regarding claim 18, it would be axiomatic to the functionality of the system that when the player is to choose the symbol as defined above by Bennett in view of Seelig that the system would assign the symbol to the player to be used in the game in order for the game to properly function in the manner defined above. Therefore, the system must be able to recognize the symbol that was chosen by the player thus it would be obvious that the symbol must be, in some manner, assigned to the player in order for proper recognition to occur.

Claim 26, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett (US Patent No. 6,093,102).

Regarding claim 26, Bennett discloses a method of playing a game having a display area comprising a plurality of rows intersecting or meeting with a plurality of columns including a plurality of symbols (FIG 5). The system plays the game as is known in the art by randomly rearranging the plurality of symbols and then displaying them. The player is then awarded when a combination of predetermined symbols appears within the display area on the lines predetermined in the manner that they were chosen by the player in the locations that were

Art Unit: 3713

selected by the player (Column 2, lines 13-16). It is known in the art that for a payline to be a winning line, the payable is set by the designer and is known to require at least two of the same symbol appearing on the line.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**US Patent No. 6,592,457:** Gaming machine that includes a number of player selected events wherein actions are required for selection by the player.

**US Patent No. 6,581,935:** (check date): Gaming device that lets the player select symbols that the player desires to be used in the game.

**US Patent No. 6,120,378:** Player has the ability to select symbols to be held that will be used in future games.

**US Patent No. 6,270,412:** Player has the ability to hold symbols for one game to be incorporated into future game.

**US Patent No. 6,336,860:** Variety of paylines are adapted to be wagered on and selected by the player.

**US Patent No. 6,604,999:** Method to define a number of paylines that are not commensurate with standard paylines.

**US Patent No. 6,551,187:** Gaming machine that includes wild symbols as the ability to move symbols around and superimpose symbols to create new symbols.


**US Patent No. 6,443,837:** Gaming machine that includes a bonus round with a monkey character as well as the ability to cause scatter pay wherein the winning combination can be in any position on the game screen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

Art Unit: 3713

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

  
cmm

September 18, 2003



**MICHAEL O'NEILL**  
**PRIMARY EXAMINER**